

REMARKS/ARGUMENTS

Result of Pre-Appeal Brief Conference

The applicant would like to thank the Examiner and other participants of the conference for the favorable decision to re-open prosecution in view of the applicant's arguments in the Request for Pre-Appeal Brief Conference.

Claim Rejections § 112

Claims 26-32 were rejected for failing to comply with the enablement requirement. The applicant disagrees. The Examiner argued that the specification fails to disclose how the combination alarm and locator system 10 is implemented so that it can possibly determine its location and transmit a location signal to a plurality of satellites for determining the location of the device. The applicant would like to point out the following instances within the specification that sufficiently discloses how device 10 can determine its location and transmit a location signal to a plurality of satellites:

Page 15, lines 3-5 of the bottom paragraph.

Page 16, lines 2-5 of the top paragraph.

Page 26, lines 7-14.

Page 27, lines 6-21.

Page 28, top paragraph.

Page 28, lines 5-8 of second paragraph.

Page 28, lines 5-9 of bottom paragraph.

Page 29, top paragraph.

Page 30, lines 3-4 of top paragraph.

Page 33, lines 1-5 of top paragraph.

Page 33, lines 1-9 of bottom paragraph.

Page 34, lines 1-9 of top paragraph.

The test of enablement is whether one skilled in the art could make or use the claimed invention from the disclosure in the patent coupled with information known in the art without undue experimentation. MPEP 2164.01. Further, a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). The state of the art existing on the filing date of the application is used to determine whether a particular disclosure is enabling as of the filing date.

The fact that experimentation may be complex does not necessarily make it undue. If the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom.*, *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

Whether undue experimentation is needed is not based upon a single factor, but rather a conclusion reached by weighing many factors. Many of these factors have been summarized in *In re Wands*, 858 F.2d 731, 98 USPQ2d 1400 (Fed. Cir. 1988) (reversing the PTO's determination that claims directed to methods for detection of hepatitis B surface antigens did not satisfy the enablement requirement). as follows:

- (1) The Scope/Breadth of the Claims
- (2) The Nature of the Invention
- (3) The State of the Art
- (4) The Relative Skill in the Art

- (5) The Amount of Direction or Guidance Present
- (6) The Predictability or Unpredictability of the Art
- (7) The Presence or Absence of Working Examples
- (8) The Quantity of Experimentation needed

In *Wands*, the court noted that there was no disagreement as to the facts, but merely a disagreement as to the interpretation of the data and the conclusion to be made from the facts. *In re Wands*, 858 F.2d at 736-40, 8 USPQ2d at 1403-07. The Court held that the specification was enabling with respect to the claims at issue and found that "there was considerable direction and guidance" in the specification; there was "a high level of skill in the art at the time the application was filed;" and "all of the methods needed to practice the invention were well known." 858 F.2d at 740, 8 USPQ2d at 1406. After considering all the factors related to the enablement issue, the court concluded that "it would not require undue experimentation to obtain antibodies needed to practice the claimed invention." *Id.*, 8 USPQ2d at 1407.

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

Here, claimed subject matter as a whole is enabled by the direction and guidance provided in the application. The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification.

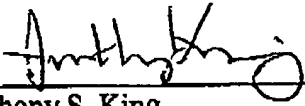
The claimed subject matter requires general understanding of satellite transmission technology, more specifically, GPS technology. One of ordinary skilled in the art would understand how a GPS receiver works with a plurality of satellites to detect the location of the

GPS receiver. A working example is a GPS device installed in a vehicle to inform the driver where the vehicle is. Typical GPS device in a vehicle, however, does not transmit a signal containing location information back to the satellite. The claimed device has a memory that keeps location information and then transmits this location information via satellites to a third party. Transmitting such location signal back to the satellite to inform a third party requires understanding of satellite transmission technology. Much is already known about transmitting signals via satellites and about various devices capable of making such transmission via satellites. In view of a well understood satellite transmission technology, the specification sufficiently provides direction and guidance, as originally filed, teaching exactly how to make and use the invention.

Request For Allowance

Claims 26-32 are pending in this application. The applicant requests allowance of all pending claims.

Respectfully submitted,
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